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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,834	12/08/2000	Neil A. Willcocks	2280.2680	1867

5514 7590 04/06/2007  
 FITZPATRICK CELLA HARPER & SCINTO  
 30 ROCKEFELLER PLAZA  
 NEW YORK, NY 10112

EXAMINER
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ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/731,834	WILLCOCKS ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-27, 29, 30, 32 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-27, 29, 30, 32 and 36-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. This office action is in response to communication filed on 1/24/2007.
2. Claims 1-10, 12-27, 29-30, 32 and 36-40 are presented for examination.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 12-27, 29-30, 32 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (6,336,099 hereinafter Barnett).

With respect to claims 1-4, 6-11, 14-19, 21, 23-27, 29-30, 32, 36, 37, 38, 39 Barnett teaches a method for motivating a consumer to promptly purchase a product and/or service electronically over a computer network (Figure 1). Providing from a server over the computer network to a consumer's computer a program that causes said computer to

(a) display an offer for sale of a product and/or service that may be purchased immediately by said consumer via the computer network (Figure 1);

( c ) when said consumer makes an electronic purchase of said of said product and/or service by electronically accepting said offer, provide to said server an indication of acceptance and a current displayed value of said incentive (Figure 1, 4);

registering at the server an initial time at which said incentive is initially displayed (i.e. the demographic data file 42 contains data representative of the demographic inquiries presented to the user at the time that the user requests a download of coupon

data from the coupon package data file 40, as well as data representative of the users' response thereto);

registering at said server an acceptance time at which said consumer electronically accepts said offer (i.e. the demographic data file 42 contains data representative of the demographic inquiries presented to the user at the time that the user requests a download of coupon data from the coupon package data file 40, as well as data representative of the users' response thereto); and

comparing said initial time and said acceptance time to verify the provided current displayed value of said incentive (i.e. the time when the coupon is presented to the user and the time when the coupon is printed is compared if a long time has passed. Eg. A month, then the coupon value is decreased to 0)(col. 11, lines 66 to col. 12, lines 1-8); providing said consumer the current value of said incentive, if the current value of said incentive is verified (i.e. if the time hasn't expired then the consumer is presented with the current value of the offer) (col. 11, lines 66 to col. 12, lines 1-8) the incentive presented via a web page (Figure 8); wherein said incentive is electronically redeemed for said verified current displayed value (i.e. the coupon is redeemed electronically for the current value)(Figure 1).

With respect to (b) concurrently display an incentive for purchasing said product and/or service promptly, wherein the program causes said incentive to be initially set to a first non-zero an initial value and then changes said incentive over a period of time to at least one other value. Barnett teaches the incentive starts with a value and if not redeemed within a predetermined period of time, the coupons will be deleted from the

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database and therefore the value will be zero (col. 12, lines 11, lines 66 to col. 12, lines 1-8). With respect to concurrently displaying the offer with the incentive to purchase said product and/or service. Since, Barnett, teaches on col. 13, lines 24-26 teaches "The availability of the coupon could be **time-sensitive**, which would provide **further incentive to the user to use the system in a prompt and efficient manner**" then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have made the offer and the incentive to purchase the product to be concurrently displayed in order to provide a reminder to the customer to promptly redeem the offer.

With respect to figure 12, Barnett further teaches wherein a consumer who frequently uses said incentive for purchasing products and/or services is accorded a more favorable incentive than a consumer who frequently uses said incentive to purchase goods and/or services (col. 12, lines 48-54).

With respect to claim 13, Barnett further teaches wherein said frequent consumer is accorded a higher maximum incentive value (col. 13, lines 30-42).

With respect to claim 20, Barnett further teaches wherein said information relates to a location of said consumer (see claims 5 and 31 Of Barnett).

Claim 5 further recites that the incentive is presented via a web banner. Official notice is taken that it is old and well known to present advertisements or the like on web

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banners. A web banner or banner ad is a form of advertising on the World Wide Web. This form of online advertising entails embedding an advertisement into a web page. It is intended to attract traffic to a website by linking them to the web site of the advertiser. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included presenting the incentive via a web banner in order to obtain the above mentioned advantage.

### **Response to Arguments**

5. Applicant argues that Barnett doesn't teach concurrent presentation of an offer to purchase and a variable incentive to make such a purchase, thus providing the motivation for an impulse to buy. See new grounds of rejection above.

6. Applicant states that even if in Barnett, the incentive and the service can be provided simultaneously by allowing the customer to purchase the products at the same time that the coupons are requested, the system is not actually performing such functions. See new grounds of rejection above.

7. Applicant argues that in Barnett, the coupon value changes without the user's knowledge. The Examiner disagrees with Applicant because in Barnett, the user is aware that the coupons are time-sensitive and that the value will decrease over time. **"this feature is included to prompt users who know of the time-sensitive....to promptly print (and use) coupons rather than risk having them deleted from their database"** (col. 12, lines 11, lines 66 to col. 12, lines 1-8). As can be seen by the above passage of Barnett, the customer is well aware of what happens to the coupon if it is not redeemed within a predetermined time period. The coupons will go from the actual

value to being deleted from the system at which time, the value of the coupons will be zero. Therefore Barnett doesn't teach way from Applicant's claimed invention.

8. Applicant argues that Barnett doesn't teach a time at which the incentive is initially displayed and the acceptance time at which the consumer accepts the offer.

The Examiner disagrees with Applicant because in Barnett, the initial time is the time at which the customer first requests/downloads/displays the coupons (figure 1, step 4) and the acceptance time is when the customer redeems the coupons (Figure 1 and 9).

9. Applicant argues that Barnett doesn't teach giving a repeat customer a more favorable incentive than a new customer. The Examiner disagrees with Applicant because Barnett teaches providing a certain higher value to known users of a brand depending on the user's redemption information (col. 13, lines 31-42). For a new customer, the system doesn't have any redemption information and thus will not provide higher coupon values.

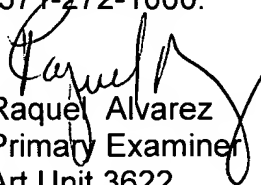
**Point of contact**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
3/19/2007